



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,977	06/10/2004	Lydia Breck	40655.0736	3976
66569	7590	12/29/2006	EXAMINER	
FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			OSBORNE, MATTHEW C	
			ART UNIT	PAPER NUMBER
			3694	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/709,977	BRECK ET AL.	
	Examiner	Art Unit	
	Matthew Osborne	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 June 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20040610, 20040810, 20060223</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the first office action on the merits for Application 10/709,977.

Claims 1-4 have been examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites “designating a non-currency based account as *at least one primary account*,” which is contradicted by the later re-introduction of “*at least one primary account*” and the later recitation “wherein said at least one primary account includes at least the designated non-currency based account.” This contradiction renders the claim indefinite because the relationship between primary and non-currency accounts is unclear. For the purposes of examination only, the claim is read initially as reciting “designating a non-currency based account” and “wherein said at least one primary account includes at least the designated non-currency based account.”

4. Claim 4 recites “issuing a credit *equal to* the transaction charge amount from the non-currency based account to the accounts receivable system” and subsequently “wherein the credit from the non-currency based account offsets *at least part of* the transaction charge.” These recitations render the claim indefinite because it is unclear whether the credit is equal to or at least part of the transaction charge. For the

purposes of examination only, it is read that the credit is "equal to" the transaction charge.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrithers et al. (US 5,689,100) in view of Walker et al. (US 6,163,771).

7. Re Claim 1, Carrithers teaches a "debit card system and method for implementing [an] incentive award program," comprising:

- designating a non-currency based account (see at least Column 5, Lines 26-31, "award account");
- at least one primary account (see at least Column 7, Lines 30-42, "DDA (demand deposit account)" which allows debit transactions to occur on a banking network, and is tied to debit cards), wherein said at least one primary account includes at least the designated non-currency based account (see at least Column 7, Lines 30-42, where checking the number of points after the parent DDA account has been verified evidences this relationship);
- converting accumulated non-currency based tender into currency to fund the primary account (see at least Column 5, Lines 26-31).

Carrithers does not teach "generating a secondary transaction number and associating said secondary transaction number with at least one primary account." However, Walker teaches a "method and device for generating a single-use financial account number" for use with credit cards which includes "accessing a first data element specific to an account; accessing a second data element including transaction-specific data; and combining the first data element and the second data element to produce the single-use financial account identifier" (see at least Column 3, Line 67, through Column 4, Line 4). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate Walker's single-use financial account number method into Carrithers' debit card system and method in order to "provide[] a method ... to facilitate secure electronic commerce, secure remote [debit] card purchases, and secure conventional [debit] card purchases wherein the customer is assured that the merchant or an intercepting third party cannot misuse any credit card information" (see at least Walker, Column 3, Lines 59-64).

8. Re Claim 2, Carrithers in view of Walker teach the limitations of Parent Claim 1, *supra*. Carrithers also teaches:

- designating condition of use parameters (see at least Abstract, "validating data for the transaction when the evaluated transaction data indicated that the transaction has been initiated by an authorized merchant using the unique account number of one of the participants having a sufficient balance in the participant's corresponding award account") and associating said parameters to

the secondary transaction number (Carrithers' associated "unique account number," *supra*, as modified in the Parent Claim 1 rejection, *supra*).

9. Re Claim 3, Carrithers in view of Walker teach the limitations of Parent Claim 2, *supra*. Carrithers also teaches:

- recognizing the transaction as involving a non-currency based account (see at least Abstract, "identifying the authorized unique account numbers of the participants ... and data indicating the balance in each participant's award account");
- verifying the conditions of use have been satisfied (see at least Abstract, "validating data for the transaction when the evaluated transaction data indicates that the transaction has been initiated by an authorized merchant ... [and] having a sufficient balance in the participant's corresponding award account"); and
- if satisfied, reducing the non-currency based account balance by the transaction amount (see at least Figure 3, Item 236).

10. Re Claim 4, Carrithers in view of Walker teach the limitations of Parent Claim 2, *supra*. Carrithers also teaches: ***finish this***

- capturing transaction settlement information in a financial capture system (see at least Figure 6, Acquirer/Processor 130, which receives settlement/disbursement information from the CC Network 102), wherein an accounts payable file is created (see at least Column 9, Lines 3-11, the "force post debit transaction" file) and the second party is paid (see at least Figure 6, "Disbursement" between Acquirer/Processor 130 and Merchant);

Art Unit: 3694

- forwarding the transaction settlement information to an accounts receivable system (see at least Column 9, Lines 12-22, forwarded to the Filter Processor 116);
- recognizing that the transaction settlement information comprises a secondary transaction number that is associated with at least a non-currency based account (see at least Column 9, Lines 12-22, the “parallel and essentially duplicate steps” of Figure 2A, as modified in Parent Claim 2 to include a secondary transaction number);
- issuing a credit equal to the transaction charge amount from the non-currency based account to the accounts receivable system (see at least Column 9, Lines 12-33, crediting or debiting a dollar account balance against the participating award account balance, in effect crediting the credit card network / A/R system); wherein the credit from the non-currency based account offsets the transaction charge (see at least Column 9, Lines 12-33).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Robinson et al. (US 5,734,838) discloses architecture for managing an incentive award program.

Walker et al. (US 6,018,718) discloses a method and system for processing customized reward offers.

Art Unit: 3694

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Osborne
Examiner
AU 3694


ELLA COLBERT
PRIMARY EXAMINER